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09/822,261	04/02/2001	William A. Knaus	8123.003.US	7290

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EXAMINER

NAJARIAN, LENA

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM A. KNAUS and RICHARD D. MARKS

Application 09/822,261

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER
MAILED:

This application was received at the Board of Patent Appeals and Interferences (BPAI) on February 5, 2008. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matter requiring attention prior to docketing is identified below.

Appellants filed an Appeal Brief on October 30, 2006. The "Summary of Claimed Subject Matter" on pages 2-4 of the Brief is non-compliant because the Summary does not **identify each independent claim by its specific number** when mapping same to its location in the specification.

37 CFR § 41.37 states in part:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section . . .

...
(v) *Summary of invention.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which must refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of 37 CFR 41.37(c)(1)(vii), every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

Appellants' "SUMMARY OF CLAIMED SUBJECT MATTER" on pages 2-4 of the brief is a detailed description of the subject matter involved in the claims on appeal and references the specification by page and line numbers. However, the Summary does not **identify each independent claim by its specific number** when mapping same to its location in the specification. The paragraphs within the Summary merely identifies the claims as an "embodiment". Correction is required.

MPEP § 1205.03 states:

When the Office holds the brief to be defective solely due to appellant's failure to provide a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v), an entire new brief need not, and should not, be filed. Rather, a paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v) will suffice. Failure to timely respond to the Office's requirement will result in dismissal of the appeal. See MPEP § 1215.04 and §711.02(b).


Accordingly, it is ORDERED that the application is returned to the Examiner

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to:

- 1) hold the Appeal Brief filed on October 30, 2006, defective;
- 2) notify Appellants to file a paper providing a summary of the claimed subject matter that fully complies with 37 CFR 41.37(c)(1)(v);
- 3) consider the paper providing a summary of the claimed subject matter as required by 37 CFR 41.37(c)(1)(v) and;
- 4) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By: 
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/vsh

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